

Appl. No.: 10/518,871

Reply to Office Action of: 11/18/2009

view of Rankin (US 2002/0039909), Rodriguez et al. (US 6,650,761), and Walter (US 6,275,141). Claims 67 and 72 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lin (WO 01/50224) in view of Rankin (US 2002/0039909), Rodriguez et al. (US 6,650,761), and Katagishi et al. (US 2003/0120745). The examiner is requested to reconsider these rejections.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Claim 42 recites, *inter alia*, "a memory configured to store a plurality of codes, each code being associated with an operation ... a controller configured to determine whether the read code corresponds with any of the plurality of codes stored in the memory ... when the read code does not correspond with any of the plurality of codes stored in the memory, to control the radio interface to transmit a message to a remote destination via the network, wherein the remote destination is dependent upon the read code".

Applicants' invention provides an apparatus which includes a memory storing a plurality of codes, each of the codes being associated with an operation. Then, when the apparatus obtains a code (e.g. through reading an RFID tag containing the code), a controller in the apparatus checks whether the obtained code matches with any of the codes stored in the memory. If the obtained code does not match any of the codes obtained in the memory, the apparatus sends a message to

Appl. No.: 10/518,871

Reply to Office Action of: 11/18/2009

a remote destination, wherein the remote destination is dependent upon the read code (i.e. the code is used in deciding the destination to send the message.)

In contrast, Lin merely discloses a facility for automatically accessing information on a computer network (abstract). Lin discloses that a routine present in application software on a user's device may obtain an RF tag and RF tag reader's unique code (page 10, lines 9 to 19). The routine may then be used to send a unique transaction code (comprising the RF tag code and RF reader code) to a system server computer which maps the code to a specific application, server or website URL. Once the unique transaction code has been sent and a URL is retrieved, a browser program is directed to retrieve the information or application.

The examiner cites page 13, lines 25 to 32, of Lin to support disclosure for determining that a read code corresponds with a stored code and performing an operation corresponding with the stored code. However, Lin discloses at page 13, lines 17 to 20, that the "... the type 3 RF tag can be used to display content such as a business card". Therefore, in Lin, as illustrated in Figure 4, the following steps occur: 1) determine type of RF tag from the RF tag code (i.e. no comparison of read codes with stored codes); 2) if RF tag is a type 3 RF tag, then perform a local operation (i.e. RF tag instructs a local operation to be performed without comparing whether the RF tag code corresponds with a stored code); 3) if RF tag is a type 1 or type 2 RF tag, proceed to obtain RF tag reader's unique RF code in order to create Unique Transaction

Appl. No.: 10/518,871  
Reply to Office Action of: 11/18/2009

Code (UTC); 4) the UTC is sent to system server computer and the URL is retrieved.

It is therefore clear that, in order to retrieve a URL, a UTC is required. The UTC is only created when using a type 1 or type 2 RF tag and is not created when using a type 3 RF tag.

Lin does not disclose "a controller configured to determine whether the read code corresponds with any of the plurality of codes stored in the memory, and when the read code corresponds with any of the plurality of codes stored in the memory, to perform an operation associated with the corresponding stored code and when the read code does not correspond with any of the plurality of codes stored in the memory, to control the radio interface to transmit a message to a remote destination via the network, wherein at least a part of the read code is used to select the remote destination".

The examiner appears to have equated the determination of the 'type' of RF tag in Lin to a feature of the present invention where the read code corresponds with a stored code. However, the recognition of the 'type' of RF tag does not involve a determination of whether the RF tag code corresponds to a stored code.

Lin clearly states at page 13, lines 22 to 26 that the type of RF tag is determined from the RF tag code (i.e. no comparing of the RF tag code with a stored code). There is no disclosure whatsoever in Lin that the RF tag code is compared with a stored code to determine the RF tag type. Therefore, the RF tag tells the user's device what type of tag it is.

Appl. No.: 10/518,871

Reply to Office Action of: 11/18/2009

It is clear in Lin that a type 3 RF tag is used to perform a local operation on the user's device and may only perform a local operation on the user's device. Therefore, when using a type 3 RF tag, no message may be transmit to a remote destination.

As shown in figures 3 and 4 of Lin, the user's device may only communicate with a system server computer 150 after creating a UTC. The UTC is only created when using a type 1 or 2 RF tag and is not created when using a type 3 RF tag. Therefore, when using a type 3 RF tag, no UTC may be created and therefore no message is transmit to a remote destination.

Applicants submit that Lin does not teach the aspect of transmitting a message to a destination in case no matching code is found, wherein the destination is dependent upon the read code. Lin does not teach such an aspect, although some look-up tables are presented in the computer 130. However, according to the teachings of Lin, the look-up tables "map unique identification codes of the RF tag 110 and RF reader 120 to specific applications, servers, or web site URLs." (page 11, lines 30-31). So, in other words, the look-up tables of Lin check whether matching code is stored and performs an associated action. Lin is silent on teaching on what to do with codes not matching the stored codes.

The Examiner provides argumentation at page 4, lines 1-7, of the Office Action in support of the rejection. This however, does not provide for a teaching of the claimed limitation, as displaying an error message when receiving a not matching code (even if the not authenticated aspect could be considered as

Appl. No.: 10/518,871

Reply to Office Action of: 11/18/2009

correlated to not matched code) is clearly different than transmitting a message to remote destination, wherein the destination is based on the received not matching code.

On the other hand, Lin teaches on page 10, lines 7-28 (and related Figure 2) a routine 200 where the apparatus transmits a message to remote system server 150 upon obtaining suitable code (RF tag type 1 or RF tag type 2 according to teachings of page 13, lines 6-32). However, the remote system server 150 is considered as a predefined remote destination, so the Lin reference lacks teaching the aspect of apparatus sending a message to a remote destination, wherein the remote destination is dependent upon the read code (i.e. the code is used in deciding the destination to send the message.) even if the RF tag types 1 and 2 could be considered as correlated with not matching code.

Furthermore, figure 3 clearly illustrates that there is only a comparison of read codes with stored codes after a UTC has been created (i.e. using the look-up table at the system server computer). When using a type 3 RF tag, no UTC is created and therefore there cannot be a comparison of read codes with stored codes. Instead, an operation is performed directly at the user's device without any code comparison. For example, business card information is directly displayed on the user's device (page 13, lines 17 to 20).

There is no teaching or suggestion in Lin to compare the code of the type 3 RF tag with a stored code in order to decide

Appl. No.: 10/518,871  
Reply to Office Action of: 11/18/2009

what local operation should be performed. Instead, the type 3 RF tag tells the user's device what to do.

The type 3 RF tag tells the user device to perform a specified local application. If a type 3 tag is used, only a local application may be performed and no message may be transmit to a remote destination.

As shown in figure 4 of Lin, if the RF Tag tells the user's device that it is a type 1 or type 2 RF tag, the RF tag reader's code may be obtained. A UTC is created and a URL is retrieved from a system server computer.

Neither the type 1 nor the type 2 RF tag may be used to perform a local operation. Furthermore, when a type 1 or type 2 RF tag is used, a UTC is always created to retrieve a URL from a server and therefore Lin does not transmit a message "when the read code does not correspond with any of the plurality of codes stored in the memory".

Lin does not disclose using a type 1 or type 2 RF tag to transmit a message "when the read code does not correspond with any of the plurality of codes stored in the memory".

Rankin discloses an electronic device provided with a reader for reading data from a physical data carrier. Rankin relates to matching obtained codes with stored codes to establish device settings associated with the obtained code (e.g. silent mode, or like when putting into purse or like...). As admitted by the Examiner in the OA (page 5, lines 9-12), the Rankin reference does not disclose the steps of matching codes locally and if not found, then transmitting the code to a

Appl. No.: 10/518,871

Reply to Office Action of: 11/18/2009

remote destination (wherein the remote destination is dependent on the obtained code).

The examiner states that it would have been obvious to modify the reference of Rankin in the manner claimed in the present application. However, applicants respectfully submit that the reasoning that the code can be transmitted to a remote destination does not alleviate the deficiencies in the cited art. This is because the assumption is that the remote destination is predefined similarly to the remote system server 150 of the Lin reference, thus not dependent upon the read and not matching code.

Rodriguez discloses various optical user interfaces that sense digitally-encoded objects. Rodriguez appears to disclose that when a not known code is received, a default application can be invoked that transmits the code to remote server for further processing. However, according to the teachings of the Rodriguez reference the remote server is once again a predefined (destination) server configured for providing the operation so the Rodriguez reference does not teach what the Lin reference lacks in teaching.

Furthermore, applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary

Appl. No.: 10/518,871

Reply to Office Action of: 11/18/2009

skill in the art. (see MPEP 2143.01, page 2100-98, column 1). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (see MPEP 2143.01, page 2100-98, column 2). A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. (see MPEP 2143.01, page 2100-99, column 1) Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). >See also Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.)

In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide the aspect of checking whether an obtained code matches with any codes stored in the memory, and if the obtained code does not match any of the codes obtained in the memory, the apparatus sends a message to a remote destination, **wherein the remote destination is dependent upon the read code**, as claimed in claim 42. Such an aspect cannot be considered as obvious to a person skilled in the art, as selecting a remote destination upon the read not matching code requires further analyzation of the not matching code in



Appl. No.: 10/518,871  
Reply to Office Action of: 11/18/2009

addition to the straightforward check whether a matching code is stored and if not, transmitting the code to predefined destination.

The features of claim 42 are not disclosed or suggested in the art of record. Therefore, claim 42 is patentable and should be allowed.

Though dependent claims 44-51, 53, 54, 56, 59, and 64-68 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 42. However, to expedite prosecution at this time, no further comment will be made.

Claim 55 recites, *inter alia*, a method comprising "transmitting a message to a remote destination via the network, wherein the remote destination is dependent upon the read code".

Similar to the arguments presented above with respect to claim 42, Lin discloses a facility for automatically accessing information on a computer network (abstract). Applicants submit that Lin does not teach the aspect of transmitting a message to a destination in case no matching code is found, wherein the destination is dependent upon the read code. Lin does not teach such an aspect, although some look-up tables are presented in the computer 130. The look-up tables of Lin check whether a matching code is stored and performs an associated action. However, Lin is silent on teaching on what to do with codes not matching the stored codes.

Appl. No.: 10/518,871  
Reply to Office Action of: 11/18/2009

The Examiner provides argumentation at page 4, lines 1-7, of the Office Action in support of the rejection. This however, does not provide for a teaching of the claimed limitation, as displaying an error message when receiving a not matching code (even if the not authenticated aspect could be considered as correlated to not matched code) is clearly different than transmitting a message to remote destination, wherein the destination is based on the received not matching code.

On the other hand, Lin teaches on page 10, lines 7-28 (and related Figure 2) a routine 200 where the apparatus transmits a message to remote system server 150 upon obtaining suitable code (RF tag type 1 or RF tag type 2 according to teachings of page 13, lines 6-32). However, the remote system server 150 is considered as a predefined remote destination, so the Lin reference lacks teaching the aspect of apparatus sending a message to a remote destination, wherein the remote destination is dependent upon the read code (i.e. the code is used in deciding the destination to send the message.) even if the RF tag types 1 and 2 could be considered as correlated with not matching code.

Rankin relates to matching obtained codes with stored codes to establish device settings associated with the obtained code (e.g. silent mode, or like when putting into purse or like...). As admitted by the Examiner in the OA (page 5, lines 9-12), the Rankin reference does not disclose the steps of matching codes locally and if not found, then transmitting the code to a remote destination (wherein the remote destination is dependent on the obtained code).

Appl. No.: 10/518,871  
Reply to Office Action of: 11/18/2009

Applicants respectfully submit that the reasoning that the code can be transmitted to a remote destination does not alleviate the deficiencies in the cited art. This is because the remote destination is predefined similarly to the remote system server 150 of the Lin reference, thus not dependent upon the read and not matching code.

Rodriguez discloses various optical user interfaces that sense digitally-encoded objects. According to the teachings of the Rodriguez reference the remote server is once again a predefined (destination) server configured for providing the operation so the Rodriguez reference does not teach what the Lin reference lacks in teaching.

Additionally, applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application). In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide a method comprising transmitting a message to a remote destination via the network, wherein the remote destination is dependent upon the read code, as claimed in claim 55. The features of claim 55 are not disclosed or suggested in the art of record. Therefore, claim 55 is patentable and should be allowed.

Though dependent claims 61 and 69-80 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 55.

Appl. No.: 10/518,871

Reply to Office Action of: 11/18/2009

However, to expedite prosecution at this time, no further comment will be made.

Claim 62 recites, *inter alia*, "transmitting a message to a remote destination via the network, wherein the remote destination is dependent upon the read code".

Similar to the arguments presented above with respect to claim 42, Lin discloses a facility for automatically accessing information on a computer network (abstract). Applicants submit that Lin does not teach the aspect of transmitting a message to a destination in case no matching code is found, wherein the destination is dependent upon the read code. Lin does not teach such an aspect, although some look-up tables are presented in the computer 130. The look-up tables of Lin check whether a matching code is stored and performs an associated action. However, Lin is silent on teaching on what to do with codes not matching the stored codes.

The Examiner provides argumentation at page 4, lines 1-7, of the Office Action in support of the rejection. This however, does not provide for a teaching of the claimed limitation, as displaying an error message when receiving a not matching code (even if the not authenticated aspect could be considered as correlated to not matched code) is clearly different than transmitting a message to remote destination, wherein the destination is based on the received not matching code.

On the other hand, Lin teaches on page 10, lines 7-28 (and related Figure 2) a routine 200 where the apparatus transmits a message to remote system server 150 upon obtaining suitable code (RF tag type 1 or RF tag type 2 according to teachings of

Appl. No.: 10/518,871  
Reply to Office Action of: 11/18/2009

page 13, lines 6-32). However, the remote system server 150 is considered as a predefined remote destination, so the Lin reference lacks teaching the aspect of apparatus sending a message to a remote destination, wherein the remote destination is dependent upon the read code (i.e. the code is used in deciding the destination to send the message.) even if the RF tag types 1 and 2 could be considered as correlated with not matching code.

Rankin relates to matching obtained codes with stored codes to establish device settings associated with the obtained code (e.g. silent mode, or like when putting into purse or like...). As admitted by the Examiner in the OA (page 5, lines 9-12), the Rankin reference does not disclose the steps of matching codes locally and if not found, then transmitting the code to a remote destination (wherein the remote destination is dependent on the obtained code).

Applicants respectfully submit that the reasoning that the code can be transmitted to a remote destination does not alleviate the deficiencies in the cited art. This is because the remote destination is predefined similarly to the remote system server 150 of the Lin reference, thus not dependent upon the read and not matching code.

Rodriguez discloses various optical user interfaces that sense digitally-encoded objects. According to the teachings of the Rodriguez reference the remote server is once again a predefined (destination) server configured for providing the operation so the Rodriguez reference does not teach what the Lin reference lacks in teaching.

Appl. No.: 10/518,871  
Reply to Office Action of: 11/18/2009

Additionally, applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application). In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide a method comprising transmitting a message to a remote destination via the network, wherein the remote destination is dependent upon the read code, as claimed in claim 62. The features of claim 62 are not disclosed or suggested in the art of record. Therefore, claim 62 is patentable and should be allowed.

Though dependent claim 63 contains allowable subject matter, the claim should at least be allowable due to dependence from allowable claim 62. However, to expedite prosecution at this time, no further comment will be made.

Claim 81 recites, *inter alia*, "a controller configured to determine whether the read code corresponds with any of the plurality of codes stored in the memory, and when the read code corresponds with any of the plurality of codes stored in the memory, to perform an operation associated with the corresponding stored code and when the read code does not correspond with any of the plurality of codes stored in the memory, to control the radio interface to transmit a message to a remote destination via the network, wherein the remote destination is dependent upon the read code".

Similar to the arguments presented above with respect to claim 42, Lin discloses a facility for automatically accessing

Appl. No.: 10/518,871  
Reply to Office Action of: 11/18/2009

information on a computer network (abstract). Applicants submit that Lin does not teach the aspect of transmitting a message to a destination in case no matching code is found, wherein the destination is dependent upon the read code. Lin does not teach such an aspect, although some look-up tables are presented in the computer 130. The look-up tables of Lin check whether a matching code is stored and performs an associated action. However, Lin is silent on teaching on what to do with codes not matching the stored codes.

The Examiner provides argumentation at page 4, lines 1-7, of the Office Action in support of the rejection. This however, does not provide for a teaching of the claimed limitation, as displaying an error message when receiving a not matching code (even if the not authenticated aspect could be considered as correlated to not matched code) is clearly different than transmitting a message to remote destination, wherein the destination is based on the received not matching code.

On the other hand, Lin teaches on page 10, lines 7-28 (and related Figure 2) a routine 200 where the apparatus transmits a message to remote system server 150 upon obtaining suitable code (RF tag type 1 or RF tag type 2 according to teachings of page 13, lines 6-32). However, the remote system server 150 is considered as a predefined remote destination, so the Lin reference lacks teaching the aspect of apparatus sending a message to a remote destination, wherein the remote destination is dependent upon the read code (i.e. the code is used in deciding the destination to send the message.) even if the RF tag types 1 and 2 could be considered as correlated with not matching code.

Appl. No.: 10/518,871

Reply to Office Action of: 11/18/2009

Rankin relates to matching obtained codes with stored codes to establish device settings associated with the obtained code (e.g. silent mode, or like when putting into purse or like...). As admitted by the Examiner in the OA (page 5, lines 9-12), the Rankin reference does not disclose the steps of matching codes locally and if not found, then transmitting the code to a remote destination (wherein the remote destination is dependent on the obtained code).

Applicants respectfully submit that the reasoning that the code can be transmitted to a remote destination does not alleviate the deficiencies in the cited art. This is because the remote destination is predefined similarly to the remote system server 150 of the Lin reference, thus not dependent upon the read and not matching code.

Rodriguez discloses various optical user interfaces that sense digitally-encoded objects. According to the teachings of the Rodriguez reference the remote server is once again a predefined (destination) server configured for providing the operation so the Rodriguez reference does not teach what the Lin reference lacks in teaching.

Wischerop discloses a reusable EAS (electronic article surveillance)/ID tag 28 and a detaching unit 26 that functions as a data reader and writer with respect to the tag 28 (column 4, lines 48 to 53). The tag 28 comprises an RFID chip 64 that is capable of storing multi-bit identification data and emitting an identification signal corresponding to the stored data in response to a radio frequency interrogation signal (column 5, lines 56 to 60).



Appl. No.: 10/518,871

Reply to Office Action of: 11/18/2009

The detaching unit 26 includes a housing 82. A nesting area 84 is provided at a top surface of the housing 82. A mechanically actuatable switch 86 is mounted in a nesting area 84 which provides an indication that a tag 28 has been positioned in a nesting area (column 7, lines 19 to 25). When a tag 28 is positioned in a nesting area 84, the switch 86 provides a signal to a control circuit 92 which causes receipt/transmit circuitry 96 and an antenna 94 to transmit an interrogation signal to stimulate the RFID transponder of the tag to generate an identification signal (column 8, lines 17 to 28).

When the identification signal is received, the control circuit 92 forwards the identifying data to a point-of-sale terminal 22. The point-of-sale terminal determines whether the detaching unit 26 should operate to remove the tag from the article of merchandise that it is attached to. If the point-of-sale terminal 22 determines that the proposed sale is a valid transaction, it will transmit to the detaching unit a signal indicating that the attaching unit should remove the EAS/ID tag 28 (column 8, lines 31 to 43). If the point-of-sale terminal did not indicate that the tag was to be removed from the article of merchandise, then the control circuit 92 writes to the RFID transponder of the tag and illuminates a warning lamp 102 to indicate that removal of the tag is not authorized (column 8, line 65 to column 9, line 10)

Furthermore, applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application).

Appl. No.: 10/518,871

Reply to Office Action of: 11/18/2009

Wischerop relates to security in commerce and the nesting area 84, which the Examiner compares to the docking port of the present invention, provides a security feature namely the removal of a security tag. It would not be obvious to isolate this feature from Wischerop and introduce it into a teaching that does not involve point of sale security such as Lin.

Lin, at page 3, lines 23 to 25, recites "...it would be desirable to have a system that simplifies access to information or services on the internet by allowing the user to automatically and quickly go to precisely the website desired".

Therefore, it is incomprehensible why a skilled person, having considered Lin, would consider Wischerop, and isolate the nesting feature of Wischerop to combine it with Lin, particularly when the nesting feature would complicate the system of Lin such that access to information or services on the internet would no longer be simple and quick.

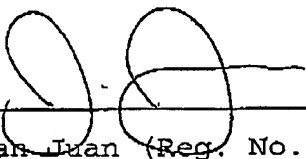
Neither Lin, Rankin, Rodriguez, nor Wischerop, alone or in combination teach the features of claim 81. The features of claim 81 are not disclosed or suggested in the art of record. Therefore, claim 81 is patentable and should be allowed.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. If there are any additional charges with respect to this Amendment or otherwise, please charge deposit account 50-1924 for any fee deficiency. Should any

Appl. No.: 10/518,871  
Reply to Office Action of: 11/18/2009

unresolved issue remain, the examiner is invited to call applicants' attorney at the telephone number indicated below.

Respectfully submitted,

  
\_\_\_\_\_  
Juan Juan (Reg. No. 60,564)

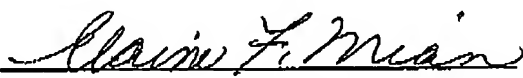
2/2/2010  
\_\_\_\_\_  
Date

Customer No.: 29683  
Harrington & Smith,  
Attorneys At Law, LLC  
4 Research Drive  
Shelton, CT 06484-6212  
203-925-9400

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

2/2/2010  
\_\_\_\_\_  
Date

  
\_\_\_\_\_  
Name of Person Making Deposit